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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GOTTSCHALK, MARTIN A

ART UNIT

PAPER NUMBER

3693

NOTIFICATION DATE

DELIVERY MODE

03/11/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 09/864,261	<b>Applicant(s)</b> HAZUMI, MICHIIRO
	<b>Examiner</b> JAY A. KRAMER	<b>Art Unit</b> 3693

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 11/19/2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,8,10,14,16,18,22,25,26 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **Acknowledgements**

This action is being sent to supplement the Office action mailed on 1/6/2011, which was mailed without the Office Action Summary page. This action corrects that deficiency and restarts Applicant's response period. Examiner further notes that the Notice of Reference cited sent with action on 1/6/2011 is not being resent as it has not changed.

### **Notice to Applicant**

1. Claims 2, 8, 10, 14, 16, 18, 22, 25, 26, and 28-32 have been examined. Claims 2, 8, 22, and 25 are currently amended. Claims 31 and 32 are new. Claims 4-7, 9, 11, 13, 15, 17, 19-21, 24, and 27 are withdrawn. Claims 1, 3-7, 9, 11-13 15, 17, 19-21, 23-24, and 27 are cancelled.

### **Continued Examination Under 37 CFR 1.114**

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/19/2010 has been entered.

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 2, 8, 10, 14, 16, 22, 25, 26 and 30-32 are rejected under 35 U.S.C. 103(a) as being anticipated by Ross et al (US Pat# 5,823,948, hereinafter Ross) in view of Maeda et al (US Pat# 6,973,458, hereinafter Maeda).

**As per claim 2**, Ross discloses an electronic medical record information management system (Ross: col 4, lns 52-53), comprising:

at least one electronic medical record information managing means;

a plurality of electronic medical record showing means;

and

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a communication network that connects the at least one of said electronic medical record information managing means to said plurality of electronic medical record showing means (Ross: Fig. 1), wherein:

each of

said plurality of electronic medical record showing means, comprises:

a first communication unit for connecting to said communication network (Ross: Fig. 1, in particular the lines connecting items 7 and 9);

and

at least one first electronic medical record terminal (Ross: Fig. 1, items 9 and 10) that

makes electronic medical records of patients and transmits said electronic medical records to said electronic medical record information managing means through said first communication unit and said communication network (Ross: col 5, lns 53 – 60),

and

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makes a request of a user to transmit one or more of said electronic medical records stored in said electronic medical record information managing means, and transmits said request to said electronic medical record information managing means through said first communication unit (Ross: col 7, lns 5 – 16, Fig. 2, items 102-103),

and

shows one or more of said electronic medical records transmitted from said electronic medical record information managing means to said user (Ross: col 5, lns 56 – 60),

and

said electronic medical record information managing means, comprises:

a second communication unit for connecting to said communication network (Ross: item 8 in particular, note that it connects items 3 and 7);

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an electronic medical record storer that stores said electronic medical records of said patients that were transmitted from said electronic medical record showing means (Ross: col 5, ln 66 to col 6, ln 3);

and

a control server (Ross: col 5, lns 22-24; Fig. 1, item 2, reads on Master Server) that obtains one or more of said electronic medical records stored in said electronic medical record, storer and transmits the obtained one or more of said electronic medical records to said electronic medical record showing means through said second communication unit (Ross: col 4, lns 52-59; col 6, lns 3-10),

wherein:

said at least one first electronic medical record terminal further includes means for adding information to each of said electronic medical records and transmits said electronic medical records and means for transmitting said electronic medical records having the added information to said electronic medical record information managing means through said first communication unit,

and

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said control server further makes said electronic medical record storer store said electronic medical records received from said electronic medical record showing means through said second communication unit (Ross: col 5, ln 66 to col 6, ln 3),

and

said control server request is made, judges whether said user who transmitted said request is a user who has a second access right or not, and when said user has said second access right, said control server makes said electronic medical record storer store said electronic medical records (Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module", note the variety of methods described by which personnel can demonstrate their identity. Note further the restrictions on types of information different types of personnel are allowed to store on the system, for example, physicians can write prescriptions, but clerks can only enter demographic information. In this example, the Examiner considers that the physician has a second access right with respect to the clerk. See below for the aspect of wherein the server makes the judgment after receiving the document request).

Ross fails to explicitly teach wherein the control server makes the judgment of proper access right after the request to transit the medical record is made. However, this feature is well known as taught by Maeda: claim 14.



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It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Ross with the teaching of Maeda in order to provide a secure but less burdensome way to edit and store important information in a document (Maeda: abstract). This would be an example of combining known prior art elements according to known methods to yield a predictable result, namely a way of managing medical records that provides improved security and convenience.

**As per claim 8**, Ross discloses an electronic medical record information management system comprising:

**Note:** Claim 8 is rejected for substantially the same reasons as provided above for claim 2. In addition the following feature of the claim is further rejected for the reasons provided:

said control server request is made, judges whether said user who transmitted said request is a user who has a first access right or not, and when said user has said first access right, said control server obtains said electronic medical record of said patient designated by said request from said electronic medical record storing server (Ross: Fig. 2, item 101; col 6, section 101 “Security Validation Module”; col 3, lns 33 – 43. See below for the aspect of wherein the server makes the judgment after receiving the document request).

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Ross fails to explicitly teach wherein the control server makes the judgment of proper access right after the request to transit the medical record is made. However, this feature is well known as taught by Maeda: claim 14.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Ross with the teaching of Maeda in order to provide a secure but less burdensome way to edit and store important information in a document (Maeda: abstract). This would be an example of combining known prior art elements according to known methods to yield a predictable result - namely a way of managing medical records that provides improved security and convenience.

**As per claims 10 and 14**, Ross discloses an electronic medical record information management system in accordance with claim 8, wherein: said electronic medical record showing means, further comprising:

a first access right information making unit that transmits first access right information with which said control server judges whether said user has said first access right or not to said electronic medical record information managing means through said first communication unit, wherein: said control server judges whether said user who transmitted said request is said user who has said first access right or not, based on said first access right information received from said electronic medical record showing means through said second communication unit (Ross: Fig. 2, item 101; col 6, section

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101 “Security Validation Module”. For claim 14 particularly, see the discussion above for the last step of claim 2 regarding a physician having a second access right as compared to a clerk with a first access right.).

**As per claim 16**, Ross discloses an electronic medical record information management system in accordance with claim 2, wherein:

said electronic medical record includes original data before new data are added (Ross: col 7, lns 18 – 31. The Examiner considers the existence of an “Historical medical record” to indicate the presence of original data prior to the addition of data from “new visits”).

**As per claims 22, 25, and 26**, they are method claims which repeat the same limitations of claims 2 and 16, the corresponding system claims, as a series of process steps as opposed to a collection of elements and are thus rejected for the same reasons as the system claims.

**As per claims 30-32**, they are rejected for the same reasons provided above for claims 2, 8 and 22 respectively.

6. Claims 18, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross in View of Maeda as applied to claim 2 above, and further in view of Wallace et al (US Pat# 6,564,121, hereinafter Wallace).

**As per claims 18 and 29**, Ross fails to explicitly disclose an electronic medical record information management system in accordance with claim 2, wherein:

when data are transmitted between said electronic medical record information managing means and said electronic medical record showing means,

said data are encrypted and said encrypted data are transmitted, and when data are received at said electronic medical record information managing means and said electronic medical record showing means, said data are decrypted.

However, these features are well in the art as evidenced by the teachings of Wallace.

Wallace teaches dispensing medical products over a networked communications system (Wallace: Abstract), with patient medical data that is encrypted locally and decrypted at a remote location (Wallace: col 16, lns 22-32; Fig. 9B, items 522 and 508).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the use of data encryption/decryption taught by Wallace into the system of Ross with the motivation of better preserving the confidentiality of patient information as it is transmitted over a network (Wallace: col 2, lns 30-35).

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**As per claim 28**, it is a method claim which repeats the same limitations of claim 18, the corresponding system claim, as a series of process steps as opposed to a collection of elements. Since the collective teachings of Ross and Wallace disclose the structural elements that constitute the system of claim 18, it is respectfully submitted that they perform the underlying process steps, as well. As such, the limitations of claim 28 are rejected for the same reasons given above for claim 18.

The motivation for incorporating the features of Ross and Wallace is as given above in the rejection of claim 18, and is incorporated herein.

### **Response to Arguments**

7. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches methods of electronically requesting access to an electronic document followed by automated authentication of user access.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARTIN A. GOTTSCHALK whose telephone number is (571)272-7030. The examiner can normally be reached on Mon - Fri 10:00 - 6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A. G./  
Examiner, Art Unit 3693

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693